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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER METZMAIER, DANIEL S	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/519,405
Filing Date: January 05, 2005
Appellant(s): BONN ET AL.

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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 November 2008 appealing from the Office action mailed 22 September 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 19 November 2008 has been entered. Attention is directed to the Advisory Action mailed 04 December 2008.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Ground (B), as denoted in the Appeal Brief of "Claims 1, 3-9, 16 and 18-22 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite" has been withdrawn in view of Appellants' After Final Amendment. Attention is directed to the Advisory Action mailed 04 December 2008.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-9, 16 and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appellants assert support for the exclusionary statements of claim 1 and 20 are provided for at page 3, lines 27 and 31. Appellants cite *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977), as controlling case law. This has not been deemed persuasive since applicants clearly did not have possession of compositions as originally filed for the following reasons.

Both components (i) and (ii) are condensation products having as one of the reactants a carboxylic acid having 12 to 36 carbon atoms and carboxylic acid having 10 to 36 carbon atoms, respectively. This overlaps with Appellants' exclusionary range of fatty acids having 12 to 26 carbon atoms. Since the ester (i) and amide (ii) formation are both equilibrium reactions that are expected to have a yield that is difficult and/or impossible to drive to 100 % completion, some fatty acid would be present in the composition. For Appellants to attempt to exclude the fatty acid component based on *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977), is improper and *In re Johnson, supra*, is not deemed to be controlling in the instant fact situation since applicants ignore the presence of fatty acids expected in components (i) and (ii). Appellants did not contemplate compositions that excluded fatty acids of 12 to 26 carbon atoms.

To attempt to exclude the "fatty acids of 12 to 26 carbon atoms" is deemed to be new matter.

(10) Response to Argument

Appellants state: "Both the species alkoxylated fatty alcohols, and fatty acids of 12 to 26 carbon atoms, are disclosed as applicable species for the hydrophobic compound recited in each of these claims, of which there is no issue. Relying on the precedent of *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977), Applicants submit that the above-excerpted recitals from Claims 1 and 20 are supported by the description requirement."

In re Johnson, 558 F.2d 1008, 194 USPQ 187 at 196 (CCPA 1977) sets forth “[the] specification, having described the whole, necessarily described the part remaining.”

Appellants’ reliance on *In re Johnson, supra*, is misplaced. While it is accurate that appellants’ original disclosure sets forth the use of “fatty acids of 12 to 26 carbon atoms” as the hydrophobic species (instant specification page 3, line 31), the disclosure of the hydrophobic element is but one of at least three elements (*i.e.*, components) in a claimed composition. Appellants’ analysis ignores the other at least two elements/components of the composition that are required to be present. Said components are further set forth in product-by-process format.

The salient point regarding *In re Johnson, supra*, and in contrast with *In re Johnson, supra*, is that:

(1) the by-products of components of (i) and (ii) of appellants claimed invention are indistinguishable from the excluded “fatty acids of 12 to 26 carbon atoms” of the hydrophobic compounds. Components (i) and (ii) are condensation products resulting from an alcohol or amine with a fatty acid by the removal of water. Said reactions are reversible by hydrolysis via an acid or base catalyst resulting in an equilibrium system, expected to be difficult to yield 100% completion. Any excess or unreacted fatty acids would have been indistinguishable in the composition from the hydrophobic fatty acids that the claims exclude.

Components (i) and (ii) are drafted in **product-by-process format**.

Component (i) sets forth "at least one polyglyceryl ester which is obtained by at least 20% esterification of polyglycerol with a carboxylic acid of 12 to 36 carbon atoms". The original specification (page 5, lines 40-42) discloses the degree of esterification of the OH groups of said "polyglyceryl ester" is at least 20 % to **100 % esterified**, preferably 60 to **100% esterified**. The original specification (page 5, lines 42 et sequa) discloses long chain fatty acids are employed for the esterification. Said limitation of 100% would have required an excess of fatty acids of 12 to 36 carbon atoms. **The disclosure is silent regarding the use of purified polyglyceryl esters or the step of separation of any excess fatty acids.**

Component (ii) sets forth "at least one bisamide of ethylenediamine and carboxylic acids of 10 to 36 carbon atoms". Appellants disclose (page 7, lines 43-45); "Particularly preferably used amides (ii) are ethylenebisstearamide, ethylenebisbehenamide and/or ethylenebislauramide". These are fatty acid bisamides. Said limitation of bis-compounds would have required an excess of fatty acids of 10 to 36 carbon atoms. **The disclosure is silent regarding the use of purified bisamides or the step of separation of any excess fatty acids.**

(2) *In re Johnson, supra*, is directed to E and E', which are linking groups in a polymer **compound** chain. As noted in *In re Johnson*, 194 USPQ 187 at 196 (CCPA 1977), examples support the limited scope of the linking groups of the polymer compound chain. This cannot be stated regarding appellants' invention.

Since appellants' claims require components (i) and (ii), which would be expected to include some fatty acids of 12 to 26 carbon numbers as by-products of said

(i) and (ii) components, appellants reliance on *In re Johnson, supra*, is misplaced and the negative limitation is deemed to be new matter.

Appellants (page 5, Appeal Brief) assert the examiner has ignored the specific claim language to ester and bisamide. It is further asserted that “It is the claim language that must be controlling and the claims do not recite that the starting carboxylic acid reactant for component (i) and for component (ii) be in excess or otherwise present in unreacted form.” It is agreed that the claims are silent to fatty acids starting materials of (i) and (ii) in excess or otherwise present in unreacted form. Therefore, the claims are generic. One skilled in the art must look to the specification to interpret said claims. Both components (i) and (ii) are disclosed and claimed to include 100% of the N (nitrogen) and OH (hydroxyl) be condensed with fatty acids. It is not unreasonable to expect the presence of excess or unreacted fatty acids.

Appellants’ (page 5, Appeal Brief) arguments regarding “alkoxylated fatty alcohols of 12 to 26 carbon atoms” is moot in view of the amendment (filed on 19 November 2008) correcting this issue.

Appellants’ (page 6, Appeal Brief) arguments regarding rejection Ground (B) (withdrawn) is moot in view of the amendment (filed on 19 November 2008) correcting this issue.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

Art Unit: 1796

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

**/Daniel S. Metzmaier/
Primary Examiner, Art Unit 1796**

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